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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/589,626	06/07/00	SCHACHAR	R PRES06-00147

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QM12/0208

EXAMINER
NGUYEN, D

ART UNIT	PAPER NUMBER
3738	6

**DATE MAILED:** 02/08/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No. <b>09/589,626</b>	Applicant(s) <b>Schachar</b>
Examiner <b>Dinh Nguyen</b>	Group Art Unit <b>3738</b>

Responsive to communication(s) filed on \_\_\_\_\_.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 1-21 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-7, 9, 11-17, 19, and 21 is/are rejected.

Claim(s) 8, 10, 18, and 20 is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-7, 11, 12, 15-17 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 4, 5, 7, 12, 15 and 17, these claims use means plus function format which is improper. Under 112 sixth paragraph, the use of means plus function is only for equivalents that are interchangeable. The different surfaces as applied to the means for stabilizing the prosthesis are actually different parts or surfaces of the prosthesis which are not interchangeable, therefore making the use of the means plus function improper.

With respect to claims 6 and 16, it is unclear what is being compared to in these claims. Applicant's use of the language "ocular tissue contact" is unclear. Is Applicant referring to the size of the surfaces of the implant for contact or the contact area of the tissue with the top and the bottom surfaces of the prosthesis? If so, it appears that they are not substantially equal because the top surface is clearly larger than the bottom surface of the prosthesis.

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With respect to claims 11 and 21, it is unclear how part of the bottom surface is partially convex. While Applicant's prosthesis has a partially concave bottom surface, as denoted by number 135 in the figures, no where in the figures does it show a convex bottom surface. Every feature as claimed must be shown in the figures. Additionally, this feature does not appear to be disclosed anywhere in the specification.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9, 11-17, 19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Georges, French Patent 2,784,287 as cited in Applicant's IDS.

Georges discloses a prosthesis having all of the claimed features. See figures 1 to 4b for example. In claim 1, it is claimed that the prosthesis increases the effective working distance of the ciliary muscles. Georges' prosthesis is shown to be implanted within the scleral pockets therefore providing this function. Applicant's dependent claims which claim a surfaces adapted to contact ocular tissue are inherent in the Georges' prosthesis it is implanted in the scleral pocket. With respect to the surface configurations, see figures. As to the stabilizing means, no definite

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means were claimed such that it differentiate from any "means" disclosed by Georges. Stabilizing is a relative terminology, such that anything is considered to stabilizing the prosthesis.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wong, USPN 4,521,210 may be applicable in a 102 rejection similarly as applied above. See figure 14b and 15b which shows convex surfaces of the implant.

***Allowable Subject Matter***

Claims 8, 10, 18 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dinh X. Nguyen whose telephone number is (703) 305-3522.



DINH X. NGUYEN  
PRIMARY EXAMINER

February 7, 2001